

RESPONSE

Claims 2-31 are pending in this application. The Examiner has rejected claims 1, 3-6, 8-10, 17-21, and 24-26 under 35 U.S.C. §102(e) over the Jahn U.S. Patent Number 6,330,487 (Jahn), and rejected claims 2, 7, 11-16, 22, 23, and 27-30 under 35 U.S.C. §103(a) over the Jahn U.S. Patent Number 6,330,487 (Jahn) in view of the Cane U.S. Patent Number 5,493,840 (Cane).

Rejection Under 35 U.S.C. §102(e) Over Jahn

The Examiner rejected pending claims 1, 3-6, 8-10, 17-21, and 24-26 under 35 U.S.C. §102(e), over Jahn, asserting that Jahn has all of the claimed elements. Applicants respectfully traverse because Jahn does not disclose (1) the use of the set of prepaints claimed by Applicants, or (2) Applicants' method for manufacturing a line of paint products from Applicants' set of prepaints.

The Examiner asserts that Jahn, by disclosing the use of raw material and resin, discloses the fluid prepaints of Applicants invention. Applicants respectfully submit that Jahn does not disclose the prepaints or the method of using them claimed by Applicants. Applicants' claim 31 clarifies that Applicants' set of prepaints contains (1) at least one fluid prepaint x, including at least one white opacifying pigment, (2) at least one fluid prepaint y, including at least one extender pigment, and (3) at least one fluid prepaint z, including at least one polymeric binder. Jahn merely discloses that his raw material and resin are combined in the paint manufacturing process. He does not, however disclose the use of the specific set of prepaints claimed by Applicants.

Further, Jahn does not disclose the use of Applicants' fixed set of prepaints to provide a line of paints. This is evidenced by the facts that (1) Jahn does not disclose the specific set of prepaints claimed by Applicants; (2) Jahn has to perform data acquisition on the raw material and the resin to determine what they are prior to performing process steps involving the raw material and resin; (3) Jahn, in several instances, refers to the raw material and the resin in the plural, but does not disclose that the raw material must be of a particular type; and (4) unlike Applicants, Jahn does not rely the ratios of the members of a set of prepaints to produce a paint

line in which each member of the line has specific paint properties, but rather he relies on the type of resin and raw material as well as the spraying equipment mechanical factors such as bell speed, shaping air and bell fluids to provide a sprayed paint having certain physical characteristics. Jahn, therefore, does not disclose the preparation of a line of paints utilizing the specific set of prepaints claimed by Applicants.

Further, Jahn does not disclose how one of ordinary skill in the art can prepare a line of paint products utilizing his raw material and resin. As noted by Applicants in the specification, by utilizing the types of prepaints specified by Applicants, a person of ordinary skill in the art can form a variety of blends to cover the key properties required for a particular line of paint. To formulate such prepaints, one needs to consider the range of key properties required by the complete paint line to formulate a set of ingredients which are capable of being blended in various combinations to cover the key properties required for the particular paint line. One of ordinary skill in the art reading Jahn would not be in possession of Applicants' invention because they would not know what type of prepaints to use in order to achieve a line of paint products utilizing a limited set of fluid prepaints.

For the above-mentioned reasons, Applicants respectfully submit that claims 31 (replaces claim 1), 3-6, 8-10, 17-21, and 24-26 are patentable over Jahn, and request that the Examiner withdraw the rejection his rejection and allow the claims as amended.

Rejection Under 35 U.S.C. §103(a) Over Jahn in view of Cane

The Examiner rejected pending claims 2, 7, 11-16, 22, 23 and 27-30 under 35 U.S.C. §103(a), over Jahn in view of Cane, asserting that Applicants' invention is obvious in view of these two references. Applicants respectfully traverse because neither Jahn nor Cane teach, disclose or suggest (1) the use of the set of prepaints claimed by Applicants, or (2) Applicants' method for manufacturing a line of paint products from a limited set of prepaints.

The Examiner asserts that Cane teaches the elements of Applicants' claimed invention that are not disclosed by Jahn. Applicants respectfully submit that, as noted above, Jahn does not disclose Applicants' claimed elements because it does not disclose (1) the use of

the set of preprints claimed by Applicants, or (2) Applicants' method for manufacturing a line of paint products from a limited set of preprints. Since Cane does not disclose either of these elements of Applicants' invention, Applicants respectfully submit that Cane does not remedy the lack of these elements in the Jahn reference. Therefore, any teachings by Cane related to tinting, water addition, or flow regulation, when combined with Jahn, would not teach Applicants' invention to one of ordinary skill in the art. Applicants therefore submit that claims 2, 7, 11-16, 22, 23 and 27-30 are patentable over Jahn in view of Cane, and request that the Examiner withdraw the rejection of 2, 7, 11-16, 22, 23 and 27-30 under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the art rejections and allow the claims as amended.

Please direct all further correspondence to the undersigned, as attorney of record.

Respectfully submitted,

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